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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,167	05/11/2001	Chen Sun		5913

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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,167

Applicant(s)

SUN ET AL.

Examiner

Marc D. Thompson

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment B, Paper #8, received 1/5/2004, has been entered into record.
2. Claims 1-46 are now pending.

Priority

3. No claim for priority has been made in this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 5/11/2001.

Specification

5. The disclosure is objected to because of the following informalities:
 1. Figure 5 is misrepresented as Figure 4 at Page 14, Line 6, of the present specification. Further, it is noted that Figure 4 is never discussed or properly referenced in the present specification.
 2. Page 1, Lines 5-9 reference a "related" application which has matured into a patent, namely, United States Patent Number 6,442,602. It is required that this fact be incorporated into the present specification, in association with this particular citation, in order to reflect accurate information and allow identification of related documentation readily. Also, this section allegedly references a claim to priority under 35 USC 120, which is improper. No claim to priority has been made in this application.
 3. Page 12, Line 19, specifies an active URL which is not currently permitted in patent applications. USPTO policy does not permit the USPTO to link to any commercial sites

Art Unit: 2144

since the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites. See MPEP § 608.01. Further, the attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See MPEP § 608.01(p), paragraph I regarding incorporation by reference.

Appropriate correction is required.

Drawings

6. The Examiner contends that the drawings submitted on 9/5/2001 are acceptable for examination proceedings.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of Choudhry (U.S. Patent No. 6,442,602),

Art Unit: 2144

hereinafter referred to as Choudhry, in view of Celik (U.S. Patent Number 6,374,259),
hereinafter referred to as Celik.

9. The present claims prescribe subject matter claimed in the patented document, minimally, with the further provision for online (electronic) business card information associated with computer users. Basic searching methodology, indexing, gateway interfacing, HTML delivery, and HTTP transports are further provided. While expressly providing the majority of the claimed invention limitations, the Choudhry patented document lends itself perfectly to the association of information with particular computer network user(s) (e.g., inter alia, Column 4, Lines 60-63, Column 7, Lines 14-46, Claim 9). Thus, the use of the virtual directory naming convention for organizing and accessing online information associated with a particular user would have been obvious to one of ordinary skill in the art at the time of invention armed with the teachings of the patented invention set forth in Choudhry, in combination with well known online electronic digital business card storage and usage methodologies.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without resorting to undue experimentation.

Art Unit: 2144

12. Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The details regarding generation and/or all potential functionality related to resolving of “virtual subdomains”, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

13. The claimed invention describes the “dynamic generation” of “virtual domains” for the purpose of business card organizing and accessing. It is unclear how this “dynamic generation” takes place, and how any results of this generation are used to organize or access online information. Further, the use of CGI scripts for potential resolving of HTML embedded addresses utilizing the virtual subdomain(s) is not set forth in the specification in sufficient detail to allow one skilled in the art to make and use the invention as claimed and disclosed. A skilled artisan would be forced to resort to undue experimentation to make and use the invention given the level of disclosure set forth in the present specification.

14. Lastly, Applicant references Choudhry (U.S. Patent No. 6,442,602) in the response, Paper #8, received on 1/5/2004, Page 12, as allegedly defining the term “virtual subdomain”. However, this document is not incorporated, by reference or otherwise, into the present specification, and so, any importation of information contained therein, is improper. The term “virtual subdomain” is not properly defined in the current specification to the extent that one skilled in the art would be able to utilize it for “organizing and access business cards”. Thus, a clear lack of enablement is present in this application.

Art Unit: 2144

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-46 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claims 15-46 each use the conjunction “and/or” as amended by Applicant in the response to elaborate upon the term “virtual subdomain”, as also argued by Applicant in the response.

The use of “and/or” renders these claims indefinite due to the inability to determine which parts of the claims/definition are part of the claimed invention. That is, it is unclear whether the limitation(s) following the phrase “and/or” are part of the claimed invention. Also see, inter alia, MPEP § 2173.05(d). It is further noted that further limiting use of “and/or” is also present, inter alia, in claim 46. All instances of “and/or” must be removed to result in specific, ascertainable scope of the claimed invention.

18. All the claims use the term “virtual subdomain” which is not defined in such exact terms to associate an ascertainable metes and bounds of the claimed subject matter.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2144

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

21. Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chandra (U.S. Patent Number 6,085,242), hereinafter referred to as Chandra, in view of Celik (U.S. Patent Number 6,374,259), hereinafter referred to as Celik, or alternatively, over Celik in view of Chandra.

22. Chandra disclosed the use of personalized URL logical designators to specify specific personal associated information for a particular network user. See, inter alia, Abstract, Column 4, Lines 27-30, and Column 6, Lines 42-45. This information was envisioned to have been business card information. See, inter alia, Column 4, Lines 17-18, and Column 5, Lines 28-32. The database housing this information was optionally part of a web server, fully incorporating the transport protocols and hypertext formatting capabilities as known in the art. See, inter alia, Column 4, Lines 8-12. Specifically, the use of "virtual subdomains" was expressly provided and utilized to reference database information. See, inter alia, Column 5, Lines 8-11, and Column 6, Lines 5-18. Lastly, the stored database information correlated directly to a dynamically generated logical designation, e.g., URL. See, Column 6, Lines 42-45.

23. Since Chandra expressly disclosed the provision for electronic business card storage and access, one of ordinary skill in the art would have been motivated to search the related arts for electronic business card teachings compatible with the Chandra system.

Art Unit: 2144

24. In the same art of information organization, storage, access, and network retrieval, Celik disclosed various network database application programming interfaces (Column 5, Lines 45-50) serving to organize and update business card entries (inter alia, Column 1, Lines 46-49). The system was functional to search business card listings in order to query/filter the information within the database utilizing typical network mechanisms. See, inter alia, Column 6, Line 66 through Column 7, Line 20.

25. The system of Chandra suggestively using a database of business card information as disclosed would have been obviously modified with the business card information database system set forth by Celik in order to result in a system fully utilizing the business card database as directly suggested by Chandra as enabled by Celik. Conversely, the central storage, management, access, and retrieval of business card database information set forth by Celik, generating a unique user identifier (inter alia, Column 7, Lines 22-31) remained silent as to how this assignment was effected. An ordinary artisan working with the Celik system at the time of invention would have been motivated to explore the related arts for teachings resulting in a generation of unique user assignment(s), as disclosed by Chandra in, inter alia, Column 6, Lines 9-16, also dealing directly with business card network user data. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings set forth by Chandra and Celik to result in a business card database organization, access, and retrieval system using typical, known network software elements, database mechanisms, information transport, and display format processing.

Claims 1-46 are rejected.

Art Unit: 2144

26. Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Choudhry (U.S. Patent Number 6,442,602), hereinafter referred to as Choudhry, in view of Celik (U.S. Patent Number 6,374,259), hereinafter referred to as Celik, or alternatively, over Celik in view of Choudhry.

27. Choudhry disclosed the use of virtual subdomain name usage using resolving features not handled by conventional domain name services (DNS). See, inter alia, Abstract, Column 4, Lines 19-38, and Column 6, Lines 10-50. Choudhry further disclosed the use of known, typical network scripts to map virtual subdomains to director(ies) and/or other logical designations, themselves resolvable into particular address(es) for information transfer. See, inter alia, Column 3, Lines 22-31, Column 4, Lines 40-63, and Column 7, Lines 15-46. It is noted that Applicant asserts complete equivalence between the terms used in the claimed invention and the Choudhry disclosure in the response, Paper #8.

28. While Choudhry disclosed the invention substantially as claimed, Choudhry did not specifically disclose the use of online business cards or the use of database functions to organize, store, access, or otherwise manipulate online business card information. The system of Choudhry was disclosed in an open-ended manner, allowing implementation of the “virtual subdomain” logical address designation to reference and manage arbitrary information sets. See, inter alia, Column 1, Lines 56-67, and Column 7, Lines 47-57. Thus, an ordinary artisan at the time of invention would have been motivated to search the related networking arts to find suitable information storage systems which would benefit from the system as disclosed by Choudhry.

Art Unit: 2144

29. In the same art of network information addressing, storage, and retrieval, Celik disclosed various network database application programming interfaces (Column 5, Lines 45-50) serving to organize and update business card entries (inter alia, Column 1, Lines 46-49). The system was functional to search business card listings in order to query/filter the information within the database utilizing typical network mechanisms. See, inter alia, Column 6, Line 66 through Column 7, Line 20.

30. Since Celik provided a specific type of information storage and retrieval system, it would have been obvious to modify the system of Choudhry with the teachings of Celik in order to effect network information storage, addressing, and retrieval in an efficient and intuitive manner of information having use to network users. See, inter alia, Choudhry, Column 4, Lines 19-64, and Celik, Columns 5-7.

31. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the addressing system of Choudhry with the business card addressing and retrieval method(s) of Celik in order to result in a fully operational online informational delivery system. Likewise, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the business card information management system of Celik with the intuitive addressing scheme set forth by Choudhry in order to provide a logical, low overhead method for generating logical information storage designations for subsequent use in search and information retrieval.

Claims 1-46 are rejected.

Response to Arguments

32. The arguments presented by Applicant in the response, Paper #8, received on 1/5/2004, are not considered persuasive.

33. Applicant asserts that “[the prior art] does not mention the term “virtual subdomain”, a key term which formed the basis of this application’s specifications and original [] claims” in the Response, Paper #8, received 1/5/2004, Page 10, Lines 6-8. While Applicant is entitled to be his own lexicographer, it is noted that functionality is at hand, not the presence or failure of the terms in the claims. The assertion of failure of pieces of prior art to precisely describe the claimed invention using the same terms is irrelevant. The true issue is the disclosure of the functionality described by the claimed terms. Applicant admits complete and full disclosure of identical functionality by Choudhry at response, Paper #8, received on 1/5/2004, Pages 12-14. Likewise, this general functionality was well known in the prior art in other sources. See, inter alia, enclosed patents, e.g., U.S. Patent Numbers 5,812,769, and 6,301,617. Likewise, the notion of electronic business cards were also notoriously well known in the art at the time of invention, further associated in DNS resource records (RRs). See, inter alia, enclosed vCard specification(s), and RFC 2426.

34. Applicant further asserts “reduction administrative cost and improved accuracy” through use of the claimed invention over the prior art of record.

1. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., functionality acting to reduce cost and improve accuracy [assumedly of name resolving and information retrieval) are not recited in the rejected claim(s). Although the claims are interpreted

Art Unit: 2144

in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Applicant's arguments may fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Also, Applicant's arguments may fail to comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

35. Finally, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Art Unit: 2144

37. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jack Harvey, can be reached at (703) 305-9705. The fax phone number for this Group is (703) 872-9306. Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

MARC D. THOMPSON
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Art Unit 2144